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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,908	08/31/2000	Mark J. Hahn	00-8012	4126

7590

02/23/2006

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EXAMINER

KANG, PAUL H

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,908

Applicant(s)

HAHN ET AL

Examiner

Paul H. Kang

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner Sajid Yussuf is no longer assigned to the present patent application. This application is now assigned to Examiner Paul H. Kang. In examining this patent application, full faith and credit has been given to the search and action of the previous examiner. MPEP § 719.05.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10, 15, 16 and 18-21 are rejected under 35 U.S.C. 101 because they are not limited to tangible embodiments, thus non-statutory.

3. As to claims 10, 15 and 16, an amendment to claim 10 to recite “[a] computer implemented method” would overcome this rejection.

4. As to claims 18-21, the specification on page 8, lines 10-12 discloses that a computer readable medium may include “carrier waves.” This is non-statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

a. A person shall be entitled to a patent unless –

b. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. ***Claim(s) 1-7, 9-16, 18-22, 25-30 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Birrell et al. (US Patent No. 6,185,551 and Birrell hereinafter).***

8. As per claim(s) 1, 9, 10, 18 Birrell discloses a personal messaging agent, comprising:

a user profile (i.e., account manager) configured to store user preferences for processing messages (See Column 5 Lines 29-48);

a message filter configured to receive one, or more messages, perform in-band processing on the message based on the user preferences (i.e., parsing, “hold back,” and message queries.

See col. 13, lines 8-23) and generate at least one event for triggering out of-band processing,

Art Unit: 2141

(i.e., adding labels and removing the unread labels) of the message based on the user preferences before receiving the message in one or more mailboxes of the user (i.e., labels, dynamic address book. See col. 8 and col. 10 and col. 9, lines 25-40); and

at least one external helper configured to perform the out-of-band processing (i.e., label state) of the messages in response to the at least one event (See Column 5 Lines 29-40 & Column 9 Lines 25-40).

9. As per claim(s) 2, 11, 19 Birrell teaches the claimed invention as described in claim(s) 1,10,18 above and furthermore discloses a message manager (i.e., mail system) configured to examine the message and modify (i.e., filter), (See Column 4 Lines 15-20) the message based on the user preferences, (See Column 5 Lines 29-48) and an event manager (i.e., mail system) configured to send the at least one event (i.e., send mail, receive mail, query index, add/remove label to/from mail) to the at least one external helper (i.e., account manager) to trigger the out-of-band processing (i.e., label state), (See Column 4 Lines 60-67 and Column 5 Lines 1-19).

10. As per claim(s) 3, 12 Birrell teaches the claimed invention as described in claim(s) 1-2 & 10-11 above and furthermore discloses a tokenizer (i.e., index server or indexer) configured to read the message and reduce the message (i.e., processed in batches) to a set of tokens (i.e., words), (See Column 7 Lines 23-45).

11. As per claim(s) 4,13,20 Birrell teaches the claimed invention as described in claim(s) 1-3, 10-12, and 18-19 above and furthermore discloses a plurality of message components (i.e.,

Art Unit: 2141

header and body) corresponding to elements of the message, (See Column 9 Lines 12-15) each of the message components being configured to recognize a specific portion of the message, (See Column 9 Lines 10-16 & Column 12 Lines 25-29) and modify the specific portion (i.e., appearance and functioning) based on the user preferences, (See Column 5 Lines 60-67).

12. As per claim(s) 5,14 Birrell teaches the claimed invention as described in claim(s) 1-4 & 10-13 above and furthermore discloses a header component configured to process a header portion of the message, (See Column 9 Lines 10-16) a separator component; (i.e., wherein the separator component is interpreted as a line/marking which separates the header from the body) configured to process a separator portion of the message, (See Figure 7) And a body component configured to process a body portion of the message, (See Column 9 Lines 10-16).

13. As per claim(s) 6,15 Birrell teaches the claimed invention as described in claim(s) 1-5 & 10-14 above and furthermore discloses the message filter (filter queries) is further configured to generate an enhanced message from the in-band processing (i.e., queries) and transmit the enhanced message, (See Column 5 Lines 29-67) for delivery to one or more mailboxes associated with one or more message recipients, (i.e., users), (See Column 5 Lines 29-48).

14. As per claim(s) 7,16 Birrell teaches the claimed invention as described in claim(s) 1-6 & 10-15 above and furthermore discloses at least one external helper (i.e., account manager) is configured to further process (i.e., change label state) the message after delivery to the one or more mailboxes (See Column 5 Lines 29-40 & Column 9 Lines 25-40).

15. As per claim(s) 21 Birrell teaches the claimed invention as described in claim(s) 18-20 above and furthermore discloses instructions for processing (i.e., labeling the message) the processed message after providing the processed message for delivery to the message recipient (i.e., user), (See Column 9 Lines 17-24).

16. As per claim(s) 22,26 Birrell discloses a server configured to receive an e-mail message from an e-mail sender and destined for one or more e-mail recipients (i.e., users) (See Column 5 Lines 7-11), a personal messaging agent, (i.e., mail system) configured to receive the e-mail message from the server, (See Column 6 Lines 11-27) process the e-mail message based on preferences of the one or more e-mail recipients (i.e., users), (See Column 5 Lines 29-48) to create (i.e., parse) a processed e-mail message and output (i.e., access) the processed e-mail message, (See Column 5 Lines 40-67) and a local delivery agent (i.e., mail server) configured to receive the processed e-mail message, (See Column 5 Lines 13-15) and store the processed e-mail message in one or more mailboxes (i.e., pop-3) associated with the one or more e-mail recipients, (i.e., user), (See Column 5 Lines 30-40); and a message retrieval system configured to retrieve the processed e-mail message, (See Column 5 Lines 7-11) from the one or more mailboxes and deliver the processed email message to the one or more e-mail recipients, (See Column 5 Lines 40-67).

17. As per claim(s) 25,27 Birrell teaches the claimed invention as described in claim(s) 22-24 & 26 above and furthermore discloses the personal messaging agent is configured to further

Art Unit: 2141

process (i.e., label) the processed e-mail message after the local delivery agent (i.e., mail server) stores the processed e-mail message in the one or more mailboxes (See Column 5 Lines 30-40 & Column 9 Lines 16-24).

18. As per claim(s) 28 Birrell teaches the claimed invention as described in claim(s) 26-27 above and furthermore discloses personal messaging agent is configured to separate the processing of the e-mail message into in-band (i.e., parsing) (See Column 7 Lines 20-39) and out-of-band processing (i.e., label state) (See Column 9 Lines 25-40); wherein the separation occurs when multiple components are given different tasks such as that of parsing (i.e., using an index server) and label state management (i.e., account manager), (See Column 5 Lines 1-6)

19. As per claim(s) 29 Birrell discloses storing e-mail processing preferences (i.e., user preferences) (See Column 5 Lines 29-48) for one or more e-mail recipients, receiving an e-mail message from an e-mail sender and destined for one or more of the e-mail recipients (i.e., users) (See Column 5 Lines 7-11); processing the e-mail message based on the e-mail processing preferences (i.e., user preferences) and providing recipients the processed e-mail message for delivery to the one or more e-mail recipients (See Column 5 Lines 40-67).

20. As per claim(s) 30 Birrell discloses a user profile configured to store user preferences (See Column 5 Lines 29-48) of a message recipient for processing a message (i.e., sending, receiving), (See Column 5 Lines 7-11) and a message filter configured to receive a message destined for the message recipient, (See Column 5 Lines 32-36 and Column 5 Lines 55-67)

Art Unit: 2141

process the message based on the user preferences (i.e., named query) to produce a processed message, and deliver (i.e., access) the processed message to the message recipient, (See Column 5 Lines 40-67).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art;
Ascertaining the differences between the prior art and the claims at issue;
Resolving the level of ordinary skill in the pertinent art; and
Considering objective evidence present in the application indicating obviousness or nonobviousness.

22. ***Claim(s) 8, 17, 23, 24 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell et al. (US Patent No. 6,185,551 and Birrell hereinafter) in view of Maurille (US Patent No. 6,484,196 and Maurille hereinafter).***

23. As per claim(s) 8,17 Birrell discloses the claimed invention as described above.

Art Unit: 2141

However, Birrell does not explicitly teach at least one external helper is configured to at least one of automatically generate a reply to the message, deliver the message to one or more alternate mailboxes, and notify the one or more message recipients of the delivery of the message.

Maurille teaches at least one external helper (i.e., message table) is configured to at least one of automatically generate a reply to the message, deliver the message to one or more alternate mailboxes, and notify the one or more message recipients of the delivery of the message (See Maurille Column 8 Lines 55-65).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Birrell with the teachings of Maurille to include a at least one external helper is configured to at least one of automatically generate a reply to the message, deliver the message to one or more alternate mailboxes, and notify the one or more message recipients of the delivery of the message with the motivation to provide for features and/or combination of features... in particular, a communication board system with multiple modes in which the communication board system can be variously configured as: a threaded mail system (See Maurille Column 2 Lines 52-67 and Column 3 Line 1).

24. As per claim(s) 23 Birrell discloses the claimed invention as described above.

However, Birrell does not explicitly teach the local delivery agent is further configured to generate status messages that indicate whether the deliveries of the modified message streams were successful.

Art Unit: 2141

Maurille teaches the local delivery agent is further configured to generate status messages that indicate whether the deliveries of the modified message streams were successful (i.e., acked), (See Maurille Column 8 Lines 53-55).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Birrell with the teachings of Maurille to include a local delivery agent is further configured to generate status messages that indicate whether the deliveries of the modified message streams were successful with the motivation to provide for features and/or combination of features... in particular, a communication board system with multiple modes in which the communication board system can be variously configured as: a threaded mail system (See Maurille Column 2 Lines 52-67 and Column 3 Line 1).

25. As per claim(s) 24 Birrell discloses the claimed invention as described above.

However, Birrell does not explicitly teach personal messaging agents are further configured to receive the status messages from the local delivery agent and provide the status messages to the server.

Maurille teaches personal messaging agents are further configured to receive the status messages from the local delivery agent and provide the status messages to the server, (See Maurille Column 3 Lines 15-27).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Birrell with the teachings of Maurille to include personal messaging agents are further configured to receive the status messages from the

Art Unit: 2141

local delivery agent and provide the status messages to the server with the motivation to provide for features and/or combination of features... in particular, a communication board system with multiple modes in which the communication board system can be variously configured as: a threaded mail system (See Maurille Column 2 Lines 52-67 and Column 3 Line 1).

Response to Amendments

26. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection. The applicants argued in substance that the examiner's mapping of the claimed invention to the prior art of record, as it pertains to the in-band and out-of-band processing, failed to anticipate the claimed invention. The new grounds of rejection teaches these features. In-band processing is deemed to be processing having direct on the message and out-of-band processing to be everything else. See Specification, page 8, line 13 – page 10, line 20.

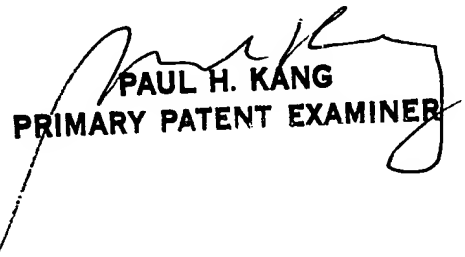
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER